



402-038-19

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

~~Applicant:~~ David G. McCarthy

: Examiner: P. Bradley - SPE-2833

~~Title:~~ Retractable Receptacle
For Furniture

: Group Art Unit: 2833

~~Serial No.~~ 08/951,276

~~Filed:~~ October 16, 1997

Commissioner for Patents
Washington, D.C. 20231

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Summary
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APPLICANT'S SUMMARY OF INTERVIEW

On March 18, 2003, the undersigned attorney conducted a telephone interview with Examiner Bradley regarding the above identified patent application.

The Final Action issued on August 31, 1999 raised both formal and prior art grounds of rejection against the claims. The prior art rejections were based upon U.S. Patent No. 4,747,788 (Byrne) and U.S. Patent No. 4,511,198 (Mitchell et al).

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to Commissioner of Patents & Trademarks, Washington, D.C. 20231, on March 24, 2003
(Date of Deposit)

Mark P. Stone
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Applicant appealed the final rejection of the claims by notice filed on December 2, 1999, and filed his Appeal Brief on January 19, 2000, arguing both the formal and prior art grounds of rejection. In the Examiner's Answer, dated April 11, 2000, the prior art rejections made in the Final Action were expressly withdrawn by the Examiner. In the Decision by the Board of Patent Appeals and Interferences dated October 31, 2002, all outstanding grounds of rejection of the appealed claims were reversed by the Board. In an Official Action dated March 7, 2003, the Examiner re-opened prosecution on the merits, and rejected the appealed claims over the identical two prior art patents which were applied in the Final Action dated October 31, 1999, and which were expressly withdrawn in the Examiner's Answer dated April 11, 2000.

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37 CFR 1.198 governs the re-opening of the prosecution of an application on the merits after a decision by the Board. This rule requires, inter alia, that prosecution can only be re-opened for "sufficient cause being shown", and only as to consideration of matters not already adjudicated.

During the interview with Examiner Bradley, the undersigned argued that the re-opening of the prosecution on the merits after a decision by the Board of Appeal, based upon the same two prior art references expressly withdrawn from the Appeal in the

Examiner's Answer, does not comply with the requirements of 37 CFR 1.198. By withdrawing the prior art rejections based upon the two prior art patents applied in the final action prior to the Appeal, the patentability of the appealed claims over these two prior art patents was adjudicated by default in Applicant's favor. Therefore, re-opening the prosecution after the decision by the Board to reject the appealed claims over the identical two prior art patents applied in the final rejection and withdrawn in the Examiner's Answer, is directed to matters already adjudicated in the appeal.

Moreover, the Official Action dated March 7, 2003, in re-opening the prosecution on the merits, fails to establish any showing of sufficient cause. On the contrary, the Official Action does not even address this issue. For example, there is no explanation as to why the Examiner, who was clearly aware of the two prior art patents applied in the final action, could not have withdrawn the final action dated August 31, 1999 based upon the arguments advanced in Applicant's Appeal Brief, and re-opened the prosecution on the merits at that time (i.e., prior to decision by the Board) to apply the two prior art references in a different manner. There is clearly no showing of sufficient cause for the withdrawal by the Examiner of the prior art rejections raised in the Final Action dated August 31, 1999, proceeding with the appeal through decision by the Board, and thereafter attempting to re-open the prosecution on the merits to assert prior art rejections of the appealed claims based on the

identical two prior art references applied in the final action and withdrawn in the Examiner's Answer.

Examiner Bradley disagreed with the position asserted by the undersigned. She stated that because the prior art rejections made in the Final Action dated August 31, 1999 were not actually adjudicated by the Board (as a result of the withdrawal of these prior art rejections in the Examiner's Answer), and since the Board's decision only adjudicated the formal grounds of rejection (which were the only outstanding grounds after the withdrawal of the prior art rejections in the Examiner's Answer), the Examiner has the right to re-open the prosecution on the merits notwithstanding the decision by the Board.

The undersigned advised Examiner Bradley that he intended to file a Petition under 37 C.F.R. 1.181 invoking the supervisory authority of the Commissioner for a ruling that the re-opening of prosecution on the merits after the decision by the Board, under the specific facts discussed above, fails to comply with the requirements of 37 C.F.R. 1.198.

Respectfully submitted,



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